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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/796,123	03/10/2004	Kiyoo Morita	Q80239	2479

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EXAMINER

HAUGLAND, SCOTT J

ART UNIT	PAPER NUMBER
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3654

DATE MAILED: 08/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/796,123

Applicant(s)

MORITA ET AL.

Examiner

Scott Haugland

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 11-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 11-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☒ Certified copies of the priority documents have been received in Application No. 10/050,112.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 3/10/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Specification***

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: The specification does not provide antecedent for the recitation in claim 11, lines 8-9 and claim 19, lines 4-5 of a reference hole in a lower surface of the cartridge case or for the recitation in claim 15, lines 8-9 of a reference hole in an upper surface of the cartridge case.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 11-16 and 19 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 9 of U.S. Patent No. 6,764,038 in view of Kaneda et al (U.S. Pat. No. 6,547,174).

Kaneda et al teaches locating reference holes 23, 24 for positioning a tape cartridge on a lower or upper (depending on the orientation of the cartridge) surface of the cartridge. Kaneda et al teaches providing a tape cartridge with a drawing-out member.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to locate the reference holes recited in claim 9 of Patent No. 6,764,038 on a lower or upper surface of the cartridge as taught by Kaneda et al to make them accessible by positioning structures in a tape drive.

With regard to claims 12, 15, and 16, it would have been obvious to provide the cartridge of claim 9 of Patent No. 6,764,038 with a drawing-out member as taught by Kaneda et al to facilitate handling of the tape.

With regard to claim 13, it would have been a matter of obvious engineering choice to locate a central portion of the drawing-out port approximately one quarter of an edge length of the side surface of the cartridge case from a corner of the cartridge case since it would have been clear to an ordinary artisan that a relatively wide range of drawing-out port positions could be used including the claimed position to form an operable cartridge.

Claims 16-18 and 21 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 14 of U.S. Patent No. 6,764,038 in view of Kaneda et al.

Kaneda et al teaches making a drawing-out member 82 of a tape cartridge so that it can be fitted in a magnetic tape drawing-out port 12, 22 of the cartridge to be fixed when the cartridge is in a state of disuse. The drawing-out member 82 forms part of a side wall of the cartridge and closes the drawing-out port when the cartridge is in a state of disuse.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to form the drawing-out member of claim 14 of Patent No. 6,764,038 so that it can be fitted in the drawing-out port of the cartridge to be fixed when the cartridge is in a state of disuse and so that the drawing-out member forms part of a side wall of the cartridge and closes the drawing-out port when the cartridge is in a state of disuse as taught by Kaneda et al to prevent accidental extraction of tape and damage to the tape or cartridge when the cartridge is not in a tape drive apparatus.

Claims 16 and 20 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 10 of U.S. Patent No. 6,764,038 in view of Kaneda et al.

Kaneda et al teaches providing a tape cartridge with a drawing-out member 82 and making the drawing-out member so that it can be fitted in a magnetic tape drawing-out port 12, 22 of the cartridge to be fixed when the cartridge is in a state of disuse.

It would have been obvious to provide the cartridge of claim 10 of Patent No. 6,764,038 with a drawing-out member as taught by Kaneda et al to facilitate handling of the tape and to make the drawing-out member such that it can be fitted in a magnetic tape drawing-out port 12, 22 of the cartridge to be fixed when the cartridge is in a state of disuse as taught by Kaneda et al prevent accidental extraction of tape and damage to the tape or cartridge when the cartridge is not in a tape drive apparatus.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 11, 12, 14-19, and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Olsen (U.S. Pat. No. 3,655,145).

Olsen discloses a magnetic tape cartridge comprising a generally rectangular cartridge case in which a single reel wound with a magnetic tape is rotatably housed. A drawing-out member 74 is provided at one end of the magnetic tape. A magnetic tape drawing-out port 56 is provided on a side surface of the cartridge case at a position apart from a corner of said cartridge case. The magnetic tape drawing-out port 56 is provided between a position corresponding to a screw hole 32 used for assembling upper and lower cases 16, 18 provided in the corner of said cartridge case, and a position corresponding to a reference hole 88 provided in the vicinity of a central portion

of the cartridge case. The reference hole is formed in upper and lower portions (in upper and lower cases) of the cartridge case. See Fig. 2. The magnetic tape is capable of being drawn out of the magnetic tape drawing out port by the drawing-out member 74.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 13 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Olsen.

Olsen discloses a magnetic tape cartridge comprising a generally rectangular cartridge case in which a single reel wound with a magnetic tape is rotatably housed, wherein a magnetic tape drawing-out port 56 is provided on a side surface of the cartridge case at a position apart from a corner of said cartridge case. The magnetic tape drawing-out port 56 is provided between a position corresponding to a screw hole 32 used for assembling upper and lower cases 16, 18 provided in the corner of said cartridge case, and a position corresponding to a reference hole 88 provided in the vicinity of a central portion of the cartridge case. A tape drawing-out member (leader) 74 is provided on an end of the magnetic tape.

Olsen does not explicitly state that the central portion of the tape drawing-out port is located at a position apart from the corner of said cartridge case by a distance equivalent to approximately one quarter of an edge length of the side of the cartridge.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to locate the tape drawing-out port 56 at a position apart from the corner of said cartridge case so that its central portion is approximately one quarter of the edge length of the side of the cartridge from the corner since Olsen shows the port in that location and it would have been clear that locating the port at that location would have been fully capable of operating as desired.

### ***Response to Arguments***

Applicants' arguments filed 3/10/05 have been fully considered but they are not persuasive.

Applicants argue that slot 88 of Olsen is not formed in a lower surface of the cartridge case. However, slot 88 is formed in upper and lower surfaces of the case since the surface of the wall 26 has upper and lower portions when the large side walls of case portions 28 and 30 are horizontal. Slot 88 is in the vicinity of a central portion of the cartridge case (i.e., in the vicinity of a central portion of a side region of the case as in Applicants' invention).

Applicants argue, regarding claim 14, that leader 74 of the tape cartridge of Olsen does not fit in the wall 26 of the cartridge and form part of the wall when the cartridge when not in use. However, as shown in Figs. 1 and 2 of Olsen, the leader 74



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is stored such that it covers tape drawing-out port 56 and forms a wall over the port.

The leader and side of the cartridge together form a cartridge side wall that has no exposed tape drawing-out port. The leader 74 is located in the tape drawing-out port 56 in this state.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott Haugland whose telephone number is (571) 272-6945. The examiner can normally be reached on Monday - Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kathy Matecki can be reached on (571) 272-6951. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*sjh*  
sjh  
8/2/05

*William A. Rivera*  
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**PRIMARY EXAMINER**